IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Bhupesh Gupta	:
	: Before the Examiner:
Serial No: 09/998,392	: Quoc A. Tran
	:
Filed: 11/29/2001	: Group Art Unit: 2176
	:
Title: APPARATUS AND METHOD	: Confirmation No.: 7315
OF HIGHLIGHTING CATEGORIZED	:
WEB PAGES ON A WEB SERVER	:

APPEALLANT'S BRIEF UNDER 37 CFR §41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In a Final Office Action dated January 11, 2006, the Examiner rejected the claims in this Application under 35 U.S.C. §103(a) as being unpatentable over Nation in view of Burke. On May 23, 2006, Applicants appealed this decision. In an Office Action dated November 28, 2006, the Examiner reopened the Application's prosecution. In that Office Action, the Examiner rejected the claims under 35 U.S.C. §103(a) as being unpatentable over Meyerzon et al. Applicants/Appellants reinstated the Appeal and argued that Meyerzon et al did not teach the claimed invention. In an Office Action dated June 22, 2007, the Examiner re-reopened prosecution of the Application and rejected the claims under 35 U.S.C. §103(a) as being unpatentable over Himmel et al. in view of Pitkow et al. Applicants/Appellants do not believe that the references teach the claimed invention or make the invention obvious and thus once more request reinstatement of the Appeal.

This Appeal Brief is submitted pursuant to a concurrently filed Notice of Appeal under 37 CFR §41.31.

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<u>BRIEF FOR APPLICANTS – APPELLANTS</u>

(i)

<u>Real Party in Interest</u>

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

<u>Related Appeals and Interferences</u>

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

<u>Status of Claims</u>

All claims in the Application (i.e., Claims 1 – 15) have been rejected. All the rejected claims are being appealed.

(iv)

<u>Status of Amendment</u>

No amendment was filed after the Final Rejection of January 11, 2006.

(v)

<u>Summary of Claimed Subject Matter</u>

The invention, as claimed in Claim 1, provides a computer implemented method of highlighting Web pages arranged in categories on a server. The computer implemented method comprises comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories (page 22, lines 1 – 10 and boxes 1705 and 1710 of Fig. 17); and highlighting all the Web pages in the

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categories that are the same as the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 – 16 and box 1715 of Fig. 17).

The invention, as claimed in Claim 4, provides a computer program product on a computer readable medium for highlighting Web pages arranged in categories on a server. The computer program product comprises code means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories (page 22, lines 1 – 10 and boxes 1705 and 1710 of Fig. 17); and code means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 – 16 and box 1715 of Fig. 17). The code means plus function are the steps outlined in Fig. 17 as well as in the text on page 22, lines 1 – 16.

The invention, as claimed in Claim 7, provides a computer implemented apparatus for highlighting Web pages arranged in categories on a server. The computer implemented apparatus comprises means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories (page 22, lines 1 – 10 and boxes 1705 and 1710 of Fig. 17); and means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 – 16 and box 1715 of Fig. 17). The means plus functions are the steps outlined in Fig. 17 as well as in the text on page 22, lines 1 – 16 processed by either processor 202 or 204 or both.

The invention, as claimed in Claim 10, provides a computer system for highlighting Web pages arranged in categories on a server. The computer system comprises at least one memory device (i.e., local memory 209, or hard disk 232 of Fig. 2) for storing code data; and at least one processor (i.e., processor 202 or 204 of Fig. 2) for processing the code data to compare bookmarked Web pages in a bookmark folder with the Web pages in the categories (page 22, lines 1 – 10 and boxes 1705 and 1710 of Fig. 17) and to highlight all the Web pages in the categories that are the same as the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 – 16 and box 1715 of Fig. 17).

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The invention, as claimed in Claim 13, provides a computer implemented method of highlighting Web pages arranged in categories on a server. The computer implemented method comprises the steps of accessing a Web page on the server on which Web pages arranged in categories are displayed (page 22, lines 1 – 5); retrieving Uniform Resource locators (URLs) of all Web pages in a bookmark folder, the bookmark folder being stored either on a client computer system or on the server (page 22, lines 5 – 9 and box 1705 of Fig. 17), the bookmark folder, if stored on the server, being enabled to be accessed by a plurality of users (page 21, lines 18 – 24); comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories (page 22, lines 9 and 10 and box 1710 of Fig. 17); and highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 - 16 and box 1715 of Fig. 17).

The invention, as claimed in Claim 14, provides a computer implemented method of indicating Web pages on a server that have already been bookmarked on a remote computer system. The computer implemented method comprises the steps of accessing a Web site on the server on which Web pages arranged in categories are displayed (page 22, lines 1 – 5); retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the remote computer system and being enabled to be viewed by a plurality of users (page 22, lines 5 – 9 and box 1705 of Fig. 17), however, only bookmarked Web pages in the bookmark folder for which a user has access permission may be accessed by the user (page 21, lines 18 – 24); comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories (page 22, lines 9 and 10 and box 1710 of Fig. 17); and highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 - 16 and box 1715 of Fig. 17).

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The invention, as claimed in Claim 15, provides a computer implemented method of indicating Web pages on a server that have already been bookmarked on a local computer system. The computer implemented method comprises the steps of accessing a Web site on the server on which Web pages arranged in categories are displayed (page 22, lines 1 – 5); retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the local computer system (page 22, lines 5 – 9 and box 1705 of Fig. 17); comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories (page 22, lines 9 and 10 and box 1710 of Fig. 17); and highlighting all the Web pages in the categories displayed on the Web site that have the same URLs with the bookmarked Web pages (see page 21, lines 28 – 32, page 22, lines 10 - 16 and box 1715 of Fig. 17).

(vi)

Grounds of Rejection to be Reviewed on Appeal

Whether claims 1 – 15 were properly rejected under 35 USC 103(a) as being unpatentable over Himmel et al. in view of Pitkow et al.

(vii)

Arguments

Whether claims 1 – 15 were properly rejected under 35 USC 103(a) as being unpatentable over Himmel et al. in view of Pitkow et al.

In considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention (taken as a whole) be determined. *Graham v. John Deere Co.,* 383 U.S. 1 (1966).

Himmel et al. teach a Web browser support for dynamic update of bookmarks. In accordance with Himmel et al. a first bookmark is stored in a browser in a computer system. In this case, the first bookmark references a web

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page at a Uniform Resource Locator (URL). A dynamic attribute to keep the first bookmark updated is used. When a change is detected in the web page data of the first bookmark, the dynamic attribute automatically updates the first bookmark to reflect the change in the web page data. The change in the web page data can be detected during a request for the web page. If redirection of the request to a new URL is detected, the first bookmark is updated to the new URL. A new request for the web page is issued using the new URL. The change in the web page data could alternatively be a change in the name of the web page.

The first bookmark may be a member of a bookmark set. The bookmark set can all have dynamic attributes, but may have member with static attributes which remain constant despite changes in the web page data. A special case of a dynamic attribute is a temporary dynamic attribute which provides that the bookmark set remain resident only for the duration of a web site browsing session. The dynamic attribute of the bookmark can be overridden by a static browser preference selectable by the user so that all bookmarks remain static in the browser.

However, Himmel et al. do not teach the steps of *comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories*; and *highlighting all the Web pages in the categories that are the same as the bookmarked Web pages*.

The Examiner seemed to argue that Himmel et al. teach the first element of the claim. Specifically, in the last paragraph on page 4 of the Office Action, The Examiner stated that "[u]sing the broadest reasonable interpretation, the Examiner reads the claimed **a bookmark folder** as equivalent to browsers have [sic] the capability to organize the bookmarks by folders, and the claimed **Web pages in the categories** as equivalent to a home page for a web site which specifies a set of URLs that can be downloaded to a web browser as a unit, a bookmark set as taught by Himmel." (Emphasis not added.)

Firstly, a bookmark folder is well known in the art as being a folder (or a directory) in which URLs of Web pages are kept so that the Web pages can be

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easily revisited at a later time. In Appellants' Specification as well as in the claimed invention, a bookmark folder is used as it is known in the field. Therefore, Appellants fail to understand how the Examiner's reading of a ***bookmark folder*** can be anything but what it is known in the field to be (i.e., a bookmark folder).

In *Pall Corp. v. Hemasure Inc.*, 50 USPQ 2d 1947, 1949 (Fed. Cir. 1999), the Court held that a patent claim is construed by examining the claim in the context of the specification, drawing on the specification for an understanding of what is covered by the claim, and looking to the rejections, explanations, and revisions that comprise the record of the patent examination.... The subject matter of the invention and its delineation in the claims is construed as it would be understood by persons knowledgeable in the field of the invention. . . . Thus a technical term is taken to have the meaning that it would ordinarily have in the field of the invention, unless it is shown that the inventor used the term with a special meaning and that persons of skill in the field would so understand the usage.

Here, Appellants do not disclose anywhere in their Specification that bookmark folders are equivalent to browsers having the capability to organize bookmarks by folders. Further, note that a browser that has the capability to organize bookmarks by folders is just a browser just like any other browsers since all browsers have that capability.

Consequently, Appellants submit that the Examiner has impermissibly construed **bookmark folder** to browsers having the capability to organize bookmarks by folders.

Secondly, "**the categories**" as used in the claims are categories in which Web pages are arranged on a server (see the pre-amble of the claim).

In *DeGeorge v. Bernier*, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985) as well as *In re Gold*, Civ. App. No. 94-1038, slip op. at 5–6 (Fed. Cir. May 31, 1994) (unpublished), and *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979) it has been

held that "where preamble limitations were "necessary to give meaning to the claim and properly define the invention," the preamble limits the claim.

Based on the meaning of "categories" as seen from the pre-amble, the Examiner may not construe "the categories" as in a "<u>home page for a web site</u> which specifies a set of URLs that can be downloaded to a <u>web browser as a unit, a bookmark set</u>." The Examiner has to instead construe "the categories" as it is defined in the preamble: Web pages arranged in categories on a server.

Thirdly, whether or not the term **a bookmark folder** is equivalent to browsers that have the capability to organize bookmarks by folders, and/or the term **Web pages in the categories** is equivalent to a <u>home page for a web site</u> etc. is irrelevant. What is relevant is whether or not Himmel et al. teach the element of comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories.

Appellants note that the Examiner did not state that Himmel et al. teach the step of ___*comparing*___ *the bookmarked Web pages with the Web pages in the categories* as stated in the claims.

Thus, Appellants reiterate that Himmel et al. do not teach the step of ___*comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories*___.

The Examiner admitted that Himmel et al. do not teach the step of highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages. However, the Examiner asserted that Pilkow et al. teach this step. Therefore, continued the Examiner, it would have been obvious for one skilled in the art to combine the teachings of Himmel et al. with those of Pilkow et al. to arrive at the claimed invention. Appellants disagree.

Pitkow et al. purport to teach a method of facilitating searching and recommending resources, or documents, based upon a collection of user document preferences (bookmarks) shared by a large group of users. In this case, Pitkow et al. leverage several of the key properties of document

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collections: only valuable documents are bookmarked; documents are usually categorized into a hierarchy; and documents can be shared. Thus, Pitkow et al. combine some attributes of bookmark systems with some attributes of search engines and recommendation systems.

Accordingly, Pitkow et al. advocate the maintenance of a centralized database of bookmarks (or user document preferences). This centralized database is maintained as a hierarchy, with individual users' bookmarks maintained separately from other users' bookmarks. The maintenance of the centralized database facilitates harnessing the power and flexibility of being able to use, in various ways, all users' public bookmarks and the information contained therein and referenced by those bookmarks. Therefore, several operations may be performed, including enhanced search and retrieval, enhanced subject-matter-based recommendation generation (for both documents and groups), and automatic document categorization and summarization.

However, Pitkow et al. do not teach the step of ***highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages*** as in the claimed invention.

The Examiner stated that in Figs. 2 and 14 and in col. 16, lines 5 – 20 Pitkow et al. teach **A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of: highlighting all the Web pages in the categories that are the same as the bookmarked Web pages**. Appellants respectfully disagree.

In col. 16, lines 4 – 20, Pitkow et al. disclose:

> It should be noted that recommendations need not be provided only in the context of an explicit request for recommendations in through the main bookmark window 210; recommendations can also be provided while a user is browsing the Web. If a Web page the user is viewing contains a link that is also a popular link (by any of the metrics defined above) in the shared bookmark collection (as a whole, or within one or more groups), then the user

can be alerted to that via the presentation of a message in the browser window. Alternatively, if there is a historical pattern of documents chosen from the shared bookmark collection (as defined by the frequency and recency metrics), then that pattern can be highlighted for the user.

One embodiment of the recommendation service is adapted to provide a user with a "substitute" bookmark when a preferred document is unavailable, as indicated by the unavailability icon 228 (FIG. 2).

Thus in the cited passage, Pitkow et al. disclose (1) a user can be alerted, through a message in the browser, that a link embedded in a Web page that the user is viewing is a popular link and (2) a historical pattern of documents chosen from the shared bookmark collection can be highlighted.

However, Pitkow et al. do not teach anywhere in the cited passage "[a] computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of: highlighting all the Web pages in the categories that are the same as the bookmarked Web pages" as asserted by the Examiner.

Further, the Examiner, again using "the broadest reasonable interpretation," reads "the claimed **Web pages in the categories** as equivalent to a Web page the user is viewing contains a link that is also a popular link, in the shared bookmark collection (as a whole, or within one or more groups), and the claimed **as the bookmarked Web pages** as equivalent to the main bookmark window 210 as taught by Himmel."

According to the Examiner, therefore, the phrase **Web pages in the categories** has two different meanings: a home page for a web site which specifies a set of URLs that can be downloaded to a web browser as a unit, a bookmark set; *and* a Web page the user is viewing contains a link that is also a

popular link, in the shared bookmark collection (as a whole, or within one or more groups).

Appellants submit that the phrase **Web pages in the categories** only means ***Web pages arranged in categories in a server*** (again see the preamble).

Appellants further submit that combining the teachings of Himmel et al. with those of Pitkow et al. does not teach the claimed invention as neither, Himmel et al. nor Pitkow et al. teach what the Examiner asserted that they teach.

Nonetheless, even if both references did teach what the Examiner asserted that they teach, their combination would not have made the claimed invention obvious.

In *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783–84 (Fed. Cir. 1992), the Court ruled that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." (quoting *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). . . . The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

As mentioned above, Himmel et al. teach a Web browser support for dynamic update of bookmarks while Pitkow et al. teach a method of facilitating searching and recommending resources, or documents, based upon a collection of user document preferences (bookmarks) shared by a large group of users. Neither one of the references contains a teaching or a suggestion that their teachings can be combined together.

Thus, Appellants submit that the Examiner has impermissibly combined the teachings of the references in a quest to make obvious the claimed invention.

Based on the foregoing, Appellants request reversal of the rejection.

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Respectfully Submitted

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Claims Appendix

1.   (Previously presented) A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of:

comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.

2.   (Previously presented) The computer implemented method of Claim 1 wherein the bookmark folder is on a client.

3.   (Previously presented) The computer implemented method of Claim 1 wherein the bookmark folder is on a server.

4.   (Original) A computer program product on a computer readable medium for highlighting Web pages arranged in categories on a server comprising:

code means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

code means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.

5.   (Previously presented) The computer program product of Claim 4 wherein the bookmark folder is on a client.

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6.   (Previously presented) The computer program product of Claim 4 wherein the bookmark folder is on a server.

7.   (Previously presented) A computer implemented apparatus for highlighting Web pages arranged in categories on a server comprising:

means for comparing bookmarked Web pages in a bookmark folder with the Web pages in the categories; and

means for highlighting all the Web pages in the categories that are the same as the bookmarked Web pages.

8.   (Previously presented) The computer implemented apparatus of Claim 7 wherein the bookmark folder is on a client.

9.   (Previously presented) The computer implemented apparatus of Claim 7 wherein the bookmark folder is on a server.

10.   (Original) A computer system for highlighting Web pages arranged in categories on a server comprising:

at least one memory device for storing code data; and

at least one processor for processing the code data to compare bookmarked Web pages in a bookmark folder with the Web pages in the categories and to highlight all the Web pages in the categories that are the same as the bookmarked Web pages.

11.   (Previously presented) The computer system of Claim 10 wherein the bookmark folder is on a client.

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12. (Previously presented) The computer system of Claim 10 wherein the bookmark folder is on a server.

13. (Previously presented) A computer implemented method of highlighting Web pages arranged in categories on a server comprising the steps of:

accessing a Web page on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all Web pages in a bookmark folder, the bookmark folder being stored either on a client computer system or on the server, the bookmark folder, if stored on the server, being enabled to be accessed by a plurality of users;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages.

14. (previously presented) A computer implemented method of indicating Web pages on a server that have already been bookmarked on a remote computer system comprising the steps of:

accessing a Web site on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the

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remote computer system and being enabled to be viewed by a plurality of users, however, only bookmarked Web pages in the bookmark folder for which a user has access permission may be accessed by the user;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web page that have the same URLs with the bookmarked Web pages.

15. (previously presented) A computer implemented method of indicating Web pages on a server that have already been bookmarked on a local computer system comprising the steps of:

accessing a Web site on the server on which Web pages arranged in categories are displayed;

retrieving Uniform Resource locators (URLs) of all bookmarked Web pages in a bookmark folder, the bookmark folder being stored on the local computer system;

comparing the URLs of the bookmarked Web pages with URLs of the Web pages in the categories; and

highlighting all the Web pages in the categories displayed on the Web site that have the same URLs with the bookmarked Web pages.

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(ix)

<u>Evidence Appendix</u>

None.

(x)

Related Proceedings Appendix

None.